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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,589	04/18/2007	Frederic Beck	026032-5042	8707
23428 7590 02/10/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER CHENEVERT, PAUL A	
			ART UNIT 3612	PAPER NUMBER
			MAIL DATE 02/10/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,589

Applicant(s)

BECK ET AL.

Examiner

Paul A. Chenevert

Art Unit

3612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-14,16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-14,16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice of Change in Examiner

1. Mike Hernandez is no longer working on this application. The new examiner of record is Paul Chenevert and he may be reached at 571-272-6657.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “cylindrical peripheral surface” (all claims) and the “irreversibly removable snap-in connection” (claims 8 & 19) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the Applicants

will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, “The disclosure concerns,” “The disclosure defined by this invention,” “The disclosure describes,” etc.

Claim Objections

4. Claims 1, 5, 7-14, 16 & 18-20 are objected to because of the following informalities:
 - a. All occurrences of “in at least one of a/the plane and a/the cylindrical peripheral surface” should be changed to “in the plane” (see the drawing objection above and the 35 USC § 112 rejection and the response to arguments indicating acquiescence of known art, both below).

b. Claim 1, line 6, the introduction of “the cover element having at least one main extension direction” is repetitive of the earlier limitation “in a direction substantially tangential to at least one main extension direction of the cover element” on line 5. The Applicants may either (1) remove this repetitive limitation or else (2) move it up to line 3 directly behind the introduction of the cover element and then also change line 5 to “the at least one main extension direction”.

c. Similarly, claim 16, line 2, either (1) “the” should be inserted before “at least one main extension direction” or else (2) claim 16 should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, 7-14, 16 & 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim limitation “cylindrical peripheral surface” is unclear from the description and drawings of the original Specification. The Summary of the Specification does repeat the language of the claims and does mention the “cylindrical peripheral surface”, but in the Detailed Description of the Specification there is no enablement of how the “cylindrical peripheral surface” is involved with

the invention. There are also no illustrations of (or references to) the “cylindrical peripheral surface” in the drawings. It is unclear the relationship of the “cylindrical peripheral surface” with the component. Simply copying the claim language into the Summary is not a proper description in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 5, 7 & 9-13 are **newly** rejected under 35 U.S.C. 103(a) as being unpatentable over Crotty, III (US 5,580,118; 03DEC96) in view of Gokuritsu (JP 2002-127819; 09MAY02).

Crotty, III discloses a component that is designed for use in a vehicle, comprising: a structural part (16) and a cover element (18), the cover element being connected to the structural

part by a removable connection (100, 106 as best seen in Figure 6), so that a connecting movement of the cover element relative to the structural part is provided to produce the connection, in a direction substantially tangential to at least one main extension direction of the cover element, substantially in a plane, and the connecting movement is carried out substantially in the plane; and first sliding elements (100) on the structural part, the first sliding elements being arranged in the plane.

In regards to all occurrences of “cylindrical peripheral surface”, the Applicants’ response on 05NOV08 does not address the Examiner’s statement of 05AUG08 that “As to claims 3 and 4, it is an obvious expedient to curve the visor assembly of Crotty, III such that the extension direction would be along a cylindrical peripheral surface and the connecting movement would be carried out in said surface in order to conform the visor assembly to a vehicle roof.” This appears to constitute acquiescence that the feature was well known in the art at the time of the invention.

In regards to claim 5, the first sliding elements (100) cooperate with second sliding elements (106) for locking the cover element relative to the structural part, at least relative to a movement perpendicular to the plane.

In regards to claim 9, the cover element is provided in the manner of a frame (90).

In regards to claims 10 & 12, the component is a sun visor with a mirror, the cover element being provided at least for covering an edge region of the mirror.

In regards to claim 13, the first sliding elements comprise a first set of three sliding elements, and the second sliding elements comprise a second set of three sliding elements, and

the first set and the second set are configured to be connected respectively by the connecting movement.

However, Crotty, III do not expressly disclose a snap-in connection provided between the cover element and the structural part for locking the cover element relative to the structural part, relative to a movement in the plane; the snap-in connection is reversibly removable.

Gokuritsu discloses a vehicular room lamp mounted to a molded ceiling with a reversibly removable snap-in connection (6, 11) provided between a cover element (10) and a structural part (2) for locking the cover element relative to the structural part, wherein the connecting movement of the cover element relative to the structural part is provided to produce the connection, in a direction substantially tangential to at least one main extension direction of the cover element, substantially in a plane, and the connecting movement is carried out substantially in the plane; first sliding elements (8) on the structural part, the first sliding elements being arranged in the plane; and second sliding elements (13) for locking the cover element relative to the structural part, at least relative to a movement perpendicular to the plane.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the component of Crotty, III, to employ a reversibly removable snap-in connection, as taught by Gokuritsu.

The suggestion/motivation for doing so would have been to lock the cover element in place so that vibration of the vehicle would not cause it to work itself loose, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the component of Crotty, III by combining a reversibly removable snap-in connection with the

cover element to obtain the invention as specified in claims 1 & 11, as taught by the prior references' motivation, and not hindsight from the Applicant's disclosure.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crotty, III, as modified, as applied to claim 1 above, and further in view of obvious common knowledge.

Crotty, III, as modified, disclose a component with a reversibly removable snap-in connection.

However, Crotty, III, as modified, do not expressly disclose the snap-in connection is irreversibly removable.

The Examiner hereby takes Official Notice that selecting a snap-in connection that is irreversibly removable is an obvious design choice, which was notoriously well known to a person having ordinary skill in the art at the time of the invention.

The suggestion/motivation for doing so would have been to allow for recycling methods, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the component of Crotty, III, as modified, by combining an irreversibly removable snap-in connection to obtain the invention as specified in claim 8, as taught by the prior references' motivation and obvious common knowledge, and not hindsight from the Applicants' disclosure.

The Applicants' response on 05NOV08 does not address the Examiner's statement of 05AUG08 that "As to claims 7 and 8, Gokuritsu teaches a simple snap-in connection that is inherently reversibly removable. It is an obvious expedient to make such a connection irreversible." This appears to constitute acquiescence that the feature was well known in the art at the time of the invention.

11. Claims 14, 16, 18 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokuritsu in view of Peterson (US 5,365,416; 15NOV94).

Gokuritsu discloses a vehicular room lamp comprising: a structural part (2) having a first set of sliding elements (8) disposed on a first side of the structural part; a cover element (10) having at least one main extension direction, substantially in a plane, and a second set of sliding elements (13) configured to interconnect with the first set of sliding elements to couple the cover element to the structural part, at least one of the first set of sliding elements and the second set of sliding elements being in the plane, the first set of sliding elements and the second set of sliding elements being arranged to be coupled by a connecting movement of one of the cover element and the structural part, relative to the other, the connecting movement being carried out in the plane; and a snap-in connection (6, 11) provided between the cover element and the structural part for locking the cover element relative to the structural part relative to a movement in the plane.

In regards to all occurrences of “cylindrical peripheral surface”, the Applicants’ response on 05NOV08 does not address the Examiner’s statement of 05AUG08 that “As to claims 3 and 4, it is an obvious expedient to curve the visor assembly of Crotty, III such that the extension direction would be along a cylindrical peripheral surface and the connecting movement would be carried out in said surface in order to conform the visor assembly to a vehicle roof.” This appears to constitute acquiescence that the feature was well known in the art at the time of the invention.

In regards to claim 16, the connecting movement is carried out in a direction substantially tangential to the at least one main extension direction of the cover element.

In regards to claim 18, the snap-in connection is reversibly removable.

In regards to claim 20,

However, Gokuritsu do not expressly disclose a sun visor for use in a vehicle, comprising: a structural part; a body part; a decorative material overlying at least a portion of the first side of the structural part; a cover element overlying one of the body part and the decorative material, wherein the cover element is coupled to the structural part with at least one of the body part and the decorative material therebetween; nor that the sun visor further comprises a mirror, the mirror having an edge region at least partially covered by the cover element.

Peterson discloses a sun visor for use in a vehicle, comprising: a structural part (18) having a first set of connecting elements (122) disposed on a first side of the structural part; a body part (29); a decorative material (25) overlying at least a portion of the first side of the structural part; a cover element (128) overlying one of the body part and the decorative material; and a mirror, the mirror having an edge region at least partially covered by the cover element; and wherein the cover element is coupled to the structural part with at least one of the body part and the decorative material therebetween.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the component of Gokuritsu, to employ the snap-in connection on a sun visor construction, as taught by Peterson.

The suggestion/motivation for doing so would have been to slidingly connect the mirror cover element to the sun visor, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the component of Gokuritsu by combining a snap-in connection with the sun visor of Peterson to

obtain the invention as specified in claim 14, as taught by the prior references' motivation, and not hindsight from the Applicants' disclosure.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gokuritsu, as modified, as applied to claim 14 above, and further in view of obvious common knowledge.

Gokuritsu, as modified, disclose a component with a reversibly removable snap-in connection.

However, Gokuritsu, as modified, do not expressly disclose the snap-in connection is irreversibly removable.

The Examiner hereby takes Official Notice that selecting a snap-in connection that is irreversibly removable is an obvious design choice, which was notoriously well known to a person having ordinary skill in the art at the time of the invention.

The suggestion/motivation for doing so would have been to allow for recycling methods, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the component of Gokuritsu, as modified, by combining an irreversibly removable snap-in connection to obtain the invention as specified in claim 19, as taught by the prior references' motivation and obvious common knowledge, and not hindsight from the Applicants' disclosure.

The Applicants' response on 05NOV08 does not address the Examiner's statement of 05AUG08 that "As to claims 17-19, Gokuritsu teaches a connection as applied previously." This appears to constitute acquiescence that the feature was well known in the art at the time of the invention.

Response to Arguments

13. Applicants' arguments filed 05NOV08 have been fully considered but they are not persuasive.

14. In response to Applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicants' disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. In response to Applicants' argument that "Peterson teaches away from a connecting movement between the "frame 128" and the "core 18" in any direction other than a direction that is perpendicular to face of the "core 18" since the "hooks 136" on the "frame 128" must be inserted through "access openings 30" provided in a "cover 22" (col. 4, lines 51-53)." the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Peterson was used to demonstrate a simple sun visor with a body and decorative material. Gokuritsu was employed to teach the sliding connection feature. To make this point more clear, in this Final rejection, the references were reversed to indicate that Gokuritsu teaches a sliding connection (i.e. the Applicants' main inventive feature)

but not on a sun visor and then would be combined with Peterson to teach the sliding connection on a sun visor having all of the internal parts.

Conclusion

16. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is (571)272-6657. The examiner can normally be reached on Mon-Fri (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GLENN DAYOAN/
Supervisory Patent Examiner, Art Unit 3612

Paul A. Chenevert
Examiner
Art Unit 3612

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